

#### **IV. REMARKS**

##### **Status of the Claims**

Claims 1,6,15,17,20-22,27,28, and 29 are amended. Claims 1-31 remain under consideration.

##### **Summary of the Office Action**

Claims 1-3,10,20,23-25 and 29-31 stand rejected under 35USC103(a) on the basis of the cited reference Sanchez, U.S. Patent No. 5,197,629 in view of the teachings of Simonotti, U.S. Patent No. 4,361,086 and Tsukasaki, U.S. Patent No. 4,363,478. The Examiner is respectfully requested to reconsider his rejection in view of the following remarks. Claims 11-14,16,18-19, and 26-27 are allowed. In addition the Examiner has indicated that claims 4-9, and 17 contain patentable subject matter.

Applicant submits that the amendments to the drawing, specification and claims fully overcome the various objections and rejections under 35USC112.

The amendments to the specification are presented to support the embodiments described in claims 8 and 17 referring to the gravity bias of the plunger. No new matter is added.

##### **Discussion of the Cited References**

The reference Sanchez describes a mechanism for dispensing cut tapes in a mailing machine. The mechanism described includes a fixed frame 80 for holding tapes for dispensing. A feed roller 116 is in continuous engagement with a cut tape and is actuated by a solenoid 140 by commands from a central controller. The feed roller is rotated by outward motion of the core member 142 under the force of spring 148. This is significantly different

then the subject system which contains the tapes in a housing that is pivotally moveable into engagement with a drive element of a envelope feed system. The feed roller of Sanchez has only one purpose and that is to engage and feed tapes on command. It is always engaged with the tape. The stack of tapes in Sanchez is fixed in an upright position and does not move.

The reference Simonotti, et al is cited as disclosing an envelope feed system. There is no mention of using cut tapes within this system. It would be a considerable technical challenge to combine the fixed dispenser of Sanchez with the complex envelope feed system of Simonotti. It is submitted that their combination would not be obvious to one skilled in the art. These teachings either alone or combine fail to disclose the pivotable tape container of this application.

The reference Tsukasaki describes a system for feeding corrugated board onto a conveyor system. This reference shows a stack of boards (A) in contact with a feed belt 11. The stack is fixed in engagement with the feed belt. This is non-analogous art and would not be considered known by someone skilled in the art of mailing machines. Nevertheless, it has nothing to encourage the modification of the system of Sanchez or Simonotti to obtain the system as claimed in this application.

Clearly the combination of teachings cited by the Examiner fall short of rendering obvious the system, as described in the independent claims 1,20,23, and 29 of this application. The references either taken alone or in combination do not support the Examiner's position.

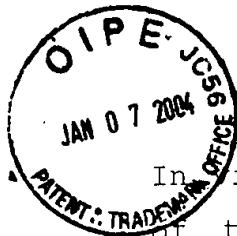
### **The Issue of Obviousness**

According to basic tenets of patent law, in order to support an obviousness rejection, there must be some suggestion of the desirability of making the modification, aside from the subject application. The claimed invention must be considered as a whole and the references must suggest the desirability and thus the obviousness of making the modification, the references must be viewed without the benefit of hindsight. (See MPEP sections 706.02(a) and 2141. Applicant submits that the modification of the teachings of Sanchez, Simonotti, and Tsukasaki in order to obtain the invention, as described in the amended claims submitted herein, would not have been obvious to one skilled in the art. There is no indication that such a modification would be possible or desirable.

It does not appear that the Examiner has considered the claims as a whole but has dismantled the claims and pursued a search for the individual features. It is well settled that "the actual determination of the issue requires an evaluation in the light of the findings in those inquiries of the obviousness of the claimed invention as whole, not merely the differences between the claimed invention and the prior art." (Graham v. John Deere Co., 383U.S.17). The court admonishes in In re Fritch, 972F.2d1260 as follow:

**"It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."**

The above arguments are equally applicable to the rejected dependent claims 2,3,15,21,24,25,28,30, and 31.



In view of the remarks stated above, Applicant submits that all of the claims under consideration contain patentable subject matter and favorable action by the Examiner is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any overpayment to Deposit Account No. 16-1350.

Respectfully submitted,

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